

## **REMARKS**

In response to the Office Action mailed on June 19, 2008, the Applicants respectfully request reconsideration in view of the following remarks. In the present application, claims 1, 14, 22, 32, and 33 have been amended. Support for the amendments can be found in the specification at least on page 7, lines 17-26 and page 10, lines 27-30. Consequently, no new matter has been added.

Claims 1-36 are pending in the application. In the Office Action:

1. Claims 1-4, 8, 9, 11, 12, 14-18, 33, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Brodersen et al. (U.S. Pat. Pub. No. 2002/0029161, hereinafter "Brodersen"); and
2. Claims 5-7, 10, 13, 19-32, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brodersen.

### **Claim Rejections - 35 U.S.C. §102(b)**

Claims 1-4, 8, 9, 11, 12, 14-18, 33, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Brodersen. The rejection of these claims is respectfully traversed.

Amended claim 1 specifies a method of defining a set of business rules during runtime of a software application program in a computer system. The method includes during runtime of the software application program, (a) specifying a current rule for the set of business rules; (b) defining at least one condition for the current rule, wherein the at least one condition comprises a decision bases on data made available to the software application; (c) defining at least one action for the current rule, wherein the at least one action is based on the at least one condition; (d) linking the at least one condition with the at least one action to define a business rule from the current rule; and (e) repeating operations (a)-(d) until each business rule in the set of business rules has been defined.

It is respectfully submitted that Brodersen fails to teach or suggest each and every feature specified in amended claim 1. For example, Brodersen fails to teach wherein the at least one condition comprises a decision based on data made available to the software application.

In contrast, Brodersen merely discusses an assignment manager that matches resources, such as employees and employee skill sets with needs. See paragraph [0014]. In Brodersen, this matching is carried out in a "Rule Based" system within a constrained environment. See paragraph [0014]. Resources, such as employees, are matched with constraints, such as skill sets, employee product expertise, language skills. See paragraph [0014].

Consequently, Brodersen discusses matching resource with needs and thus fails to disclose conditions including a decision made available to a software application. Rather Brodersen is silent regarding conditions being decisions.

Thus, based on the foregoing, amended claim 1 is allowable over Brodersen and the rejection of this claim should be withdrawn. Claims 2-4, 8, 9, 11, and 12 depend from amended claim 1, and are thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

Amended independent claims 14 and 33 each specify similar features as amended claim 1 and thus are allowable over Brodersen for at least the same reasons. Based on the foregoing, Brodersen fails to teach, disclose, or suggest each of the features specified in claims 14 and 33. Therefore, claims 14 and 33 are allowable and the rejection of these claims should be also withdrawn. Claims 15-18 depend from amended claim 14 and claim 34 depends from amended claim 33. Thus, these claims are allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

**Claim Rejections - 35 U.S.C. §103(a)**

Claims 5-7, 10, 13, 19-32, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brodersen. The rejection of these claims is respectfully traversed.

Claims 5-7, 10, and 13 depend from amended claim 1, and are thus allowable for at least the same reasons stated above regarding amended claim 1. Therefore, the rejection of these claims should also be withdrawn.

Claims 19-21 depend from amended claim 14, and are thus allowable for at least the same reasons stated above regarding amended claim 14. Therefore, the rejection of these claims should also be withdrawn.

Claims 35 and 36 depend from amended claim 33, and are thus allowable for at least the same reasons stated above regarding amended claim 33. Therefore, the rejection of these claims should also be withdrawn.

Amended claims 22 and 32 specify similar features as amended claims 1 and 14 and is thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

Claims 23-31 depend from amended claim 22, and are thus allowable for at least the same reasons. Therefore, the rejection of these claims should also be withdrawn.

**Official Notice**

Claims 5-7, 10, 13, 19, 22, and 32 are rejected using “Official Notice.” The rejection of these claims is respectfully traversed.

The Office Action takes Official Notice that many of the features claimed in claims 5-7, 10, 13, 19, 22, and 32 are “old and well known in the art.” See Office Action, pages 6-9, 11 and

13. As a result, the applicant respectfully submits that the Office Action fails to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teaches or suggests every claim limitation. KSR, 550 U.S. \_\_\_\_; 82 USPQ2d 1385. See also MPEP 2143.

To adequately traverse Official Notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also In re Chevenard, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943).

Applicant respectfully submits it is never appropriate to rely solely on Official Notice without evidentiary support in the record, as the principal evidence upon which a rejection was based. In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board [and Examiner] cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board [and Examiner] must point to some concrete evidence in the record in support of these findings."). As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidentiary support. Id. at 1385, 59 USPQ2d at 1697.

The applicant respectfully submits that the Office Action merely states various claimed features are "old and well known in the art" and provides no evidentiary support for such conclusory statements. For example, the Office Action states that "placing cusomtized [sic] operations in a script is old and well known in the art." See Office Action, page 8. The Office Action further states that Brodersen teaches that an action can be based on decisions in which customized operations are performed and that Brodersen fails to teach placing customized

operation in a script. Id. Because Brodersen fails to teach scripts, let alone placing customized operations in scripts, the mental leap between decisions based on customized operation and operations being placed in scripts is just too great without evidentiary support. Consequently, because the Office Action provides no evidentiary support for its conclusions, the taking Official Notice is improper.

By pointing out that the Office Action is merely making a conclusory statement without evidentiary support, the applicant has adequately traversed the taking of Official Notice because the courts have clearly held that making a conclusory statement without evidentiary support in the record is improper. Thus, the Office must provide documentary evidence in the next Office Action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or Examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test).

### **Conclusion**

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,  
MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(404) 954-5064

Date: September 18, 2008

/Alton Hornsby III/  
Alton Hornsby III  
Reg. No. 47,299

